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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,935	01/30/2001	Gerardo R. Vasta	4115-137 CIP	9125

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INTELLECTUAL PROPERTY / TECHNOLOGY LAW
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EXAMINER

MYERS, CARLA J

ART UNIT PAPER NUMBER

1634

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/771,935

Applicant(s)

VASTA ET AL.

Examiner

Carla Myers

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-4, 9-13, 15-18 and 20-31.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Carla Myers
CARLA J. MYERS
PRIMARY EXAMINER

Continuation of 2. NOTE: the amendments to the claims raise new issues that would require further search and consideration. The amendment to recite "wherein the oligonucleotide hybridizes to the NTS under stringent annealing conditions for species-specific detection" raises new issues under 35 USC 112 first paragraph (new matter) and second paragraph. While the specification discusses species specific detection, the specification does not refer to or define stringent annealing conditions for species-specific detection. It is unclear as to what constitutes these conditions and it is unclear as to whether the oligonucleotide is species specific or if the claim only seeks to define a portion of the oligonucleotide which is capable of hybridizing to some degree under the undefined "stringent annealing conditions" to the NTS of a species. In claim 3, it is unclear as to what is intended to be meant by the recitation of determining the identity of *Perkinsus atlantis*. While it is clear as to what is meant by determining the identity of a microorganism, it is unclear as to how one further determines the identity of an organism that is *Perkinsus atlantis*. Also, in claim 3, the phrase "the non-transcribed spacer nucleotide sequence" lacks proper antecedent basis. Further, in claim 3 "identity *Perkinsus atlanticus*" should read "identity of *Perkinsus atlanticus*" and in claim 2, the recitation "(see page 17, last sentence of paragraph)" should be deleted from the claim.

Continuation of 5. does NOT place the application in condition for allowance because: for the reasons of record in view of the non-entry of the after final amendment. Further, the 132 declaration is not sufficient to overcome the previous 102 and 103 rejections. It is unclear as to how statements 3 and 4 in the declaration relate to the individual rejections. Robeldo "2" and "3" were applied as a 102(a) rejection over several claims, including claim 4. However, the declaration only addresses claims 1-3, 9-13, 15-18 and 20 with respect to these 2 references.